

**IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Applicant:)	I hereby certify that this paper and the
)	documents are being submitted
Marcus Braun)	electronically with the US Patent and
)	Trademark Office on this date:
U.S. Serial No.: 10/815,395)	
)	July 6, 2009
For: SURGICAL INSTRUMENT)	
)	
Filed: April 1, 2004)	
)	<u>/Joseph T. Jasper/</u>
Group Art Unit: 3739)	Joseph T. Jasper
)	Registration No.: 50,833
Examiner: Michael F. Peffley)	Attorney for the Applicant

REQUEST FOR CORRECTED OFFICE ACTION UNDER MPEP 710.06

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The applicant is in receipt of the official action dated June 4, 2009. The action contains several errors that affect the applicant's ability to reply. These errors are being brought to the attention of the Office within one month of the mail date of the action as July 4, 2009 is a holiday and fell on a weekend. In accordance with MPEP 710.06, the applicants respectfully request a new office action issue that addresses these errors.

Claims 1-16 are pending. The action of June 4, 2009, rejects claims 1-16 as unpatentable over Yoon (US 5,954,731) and Hassler (US 5,374,277) (see office action, page 2). The action then provides an explanation of how claim 1 is described in Yoon

and Tovey (see office e action, page 2). The Office is requested to clearly explain if the claims are rejected based on Yoon and Hassler or Yoon and Tovey.

Furthermore, the action fails to discuss any of the remaining dependent claims (i.e., claims 2-13 ,15 and 16), which provide additional limitations over the independent claims. For example, claim 2 states that the instrument handle forms an operating mechanism for bending the instrument head with respect to the tube shaft. Claim 3 states that the instrument handle is constructively pivotable past a parallel position with respect to the tube shaft. The action fails to provide any explanation as to where these limitations are found in the art or how the Office is rejecting the claims based on the art. The same can be said for each of the dependent claims.

The undersigned contacted the examiner via telephone to discuss the missing rationale for rejecting the dependent claims. The examiner stated that they were discussed in prior actions. However, claims 15 and 16 were added in response to the last action and, thus, could not have been discussed earlier. Further, the prior action of October 18, 2008, also fails to discuss the dependent claims. Finally, the first action of October 3, 2006, issued under a different examiner and applied completely different art.

The applicant has paid for full and complete examination in which each claim and each limitation is fully considered. The Office has repeatedly failed to comply with its legal duties of providing complete examination. M.P.E.P. 2143.03 unequivocally states, “**All words** in a claim **must be considered** in judging the patentability of that claim against the prior art.” (*citing In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970))

(emphasis added)). In addition, 37 C.F.R. 1.104 states that “examination shall be complete” (emphasis added). Furthermore, the examiner has a duty to “evaluat[c] each claim limitation... [and] correlate each claim limitation to all portions of the disclosure [in the prior art] that describe the claim limitation.” M.P.E.P. 2106 (II)(C) (emphasis added). Therefore, “when evaluating the scope of a claim, every limitation in the claim must be considered.” *Id.* (emphasis added).

Because the present action is confusing as to what art is being applied and ignores the majority of the pending claims, the action is incomplete and the applicant is unable to adequately respond. Therefore, a new action with a fully reset time period to respond is earnestly requested.

No fee is due. However, the Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 50-2455. Please refund any overpayment to Hanley, Flight & Zimmerman, LLC at the address below.

Respectfully submitted,

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